

REMARKS/ARGUMENTS

The Applicants have carefully considered this application in connection with the Examiner's Action and respectfully request reconsideration of this application in view of the following remarks.

The Applicants originally submitted Claims 1-20 in the application. The Applicants have previously canceled Claims 7 and 17. Accordingly, Claims 1-6, 8-16 and 18-20 are currently pending in the application.

I. Rejection of Claims 1-14, 16 and 18-20 under 35 U.S.C. §103

These claims are rejected under 35 U.S.C. §103(a) as unpatentable over Benninghoven, Harris 995' or Harris 862' in further view of U.S. Patent No. 5,997,509 to Rosengart, et al. (Rosengart). The Applicants respectfully submit that these references fail to establish a *prima facie* case of obviousness regarding these claims. As previously presented, Benninghoven teaches only a sampler for a very large spectrometer, but it does not teach a need for the sampler to include a plunger and cooperative spring that retracts the platen into the body of the sampler, as recited in independent Claims 1 and 11. Moreover, this is particularly the case given that the sampler as taught and suggested by Benninghoven is a stationary sample for a very large and sophisticated spectrometer and given that the sampler is used to analyze the sample and not used to collect it. Nonetheless, the Examiner asserts that it would be obvious to combine the teachings of Benninghoven with either Harris 995' or Harris 862' that teach only a plunger. To provide yet another missing piece of the presently claimed inventions, the Examiner presently asserts that one skilled in the art would combine the teachings of still another reference, Rosengart, to provide the

missing piece of the a plunger with a cooperative spring that is configured to retract the platen into the sampler body as recited in the claimed inventions.

The Examiner's *prima facie* case fails for at least two reasons. First, there is simply no motivation to combine these four references in the way suggested by the Examiner except with the use of hindsight, which, as is well established, is improper. Second, even when combined, the combination fails to teach a retractable platen on which a sampling medium can be attached. Benninghoven doesn't teach or suggest this. Harris 995' doesn't teach or suggest this, and neither does Harris 862.' Roesengart equally fails to teach or suggest such a device. The device in Rosengart is a mechanism for delivering a therapeutic substance through a needle that is coupled to a platen operable with a spring and plunger. Except for the spring and plunger, Rosengart teaches or suggests a device whose purpose is opposite that of the device taught in Rosengart. The presently claimed device is used to gather a sample onto a medium that is attached to a retractable platen, whereas Roesengart discloses a device that is directed to a needle attached to a platen for delivering a therapeutic substance to a targeted tissue and not designed to collect a specimen.

In essence, the Examiner is taking the sampler of Benninghoven, the plunger from Harris 995' or Harris 862,' and the spring and plunger from Rosengart and combining them to reject the presently claimed inventions. This is nothing short of picking and choosing the respective elements from a number of references with the benefit of hindsight to establish a basis for a 103 rejection, when the invention as a whole is not taught or suggested by the combination. The Federal Circuit has consistently held this is improper. *W.L. Gore & Associates, Inc. v. Garlock*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Moreover, other than by conclusory statements, the Examiner has not pointed to any teaching or suggestion in any of these references that would motivate one to combine the references. The Board of Appeals has held that a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Ex parte Hammond*, 41 USPQ 1217 (BdPatApp&Int 1996).

In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 1-6, 8-16 and 18-20 under 35 U.S.C. §103(a). The Applicants therefore respectfully request the Examiner withdraw the rejection.

II. Rejection of Claim 15 under 35 U.S.C. §103

This claim is rejected as unpatentable over Benninghoven in view of Houge. Claim 15 depends from Claim 11, and as discussed above, Benninghoven fails to teach or suggest the elements of Claim 11, and therefore, also fails to teach or suggest all of the elements of Claim 15. As noted by the Examiner, Houge provides no other teaching other than to teach a turret system that rotates a sample in a mass spectrometer. Therefore, the asserted combination fails to establish a *prima facie* case of obviousness with respect to this claim as well. In addition, however, the Applicants respectfully submit that one who is skilled in the art would not know to take the turret system of a mass spectrometer and apply it to a sample collector without the benefit of hindsight.

In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claim 15 under 35 U.S.C. §103(a). The Applicants therefore respectfully request the Examiner withdraw the rejection.

IV. Conclusion

In view of the foregoing amendment and remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a Notice of Allowance for Claims 1-6, 8-16 and 18-20.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present application.

Respectfully submitted,

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